

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Christopher Chen
Serial No: 10/065,776
Filed: November 18, 2002

Confirmation No 2410
Group: 3725
Examiner: Larson, Lowell
A.

For: Method and Apparatus for the
Processing of Used Tires and
Other Materials

Attorney Docket No.	23399.0001
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RESPONSE TO RESTRICTION REQUIREMENT

VIA FACSIMILE: 703-872-9306
Mail Stop: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the Office Action mailed July 8, 2004 (Paper No. 6), Applicant hereby makes the following election:

Applicant elects Claims 18 to 47 for examination.

Applicant also respectfully traverses the grounds of the present restriction requirement.

The Patent Office has stated:

"Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 to 17, drawn to a method and apparatus for comminuting and separating material, classified in class 241, subclass 24.17.
- II. Claims 18 to 47, drawn to methods and apparatus for cryogenically reducing material, classified in class 241, subclass 23.
- III. Claims 48 to 52, drawn to a method of sorting particulate material, classified in class 209, subclass 233.

The inventions are distinct, each from the other because of the following reasons."

What 35 U.S.C. 121, the law, states in relevant part is: "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." Note that 37 C.F.R. §§ 1.141 and 1.142 also speak of "independent and distinct" inventions. The Patent Office has only argued that the inventions are

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distinct. The Patent Office has not also argued, as required by 35 U.S.C. 121, that the inventions are also independent. Therefore, the restriction requirement is improper and Applicant requests that it be withdrawn.

Note that Applicant does not consider the explanation of the meaning of "independent" and "distinct" in MPEP § 802.01 persuasive.

The MPEP §802.01 Meaning of "Independent" and "Distinct":

"35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. In 37 CFR 1.141, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

This raises the question of the subjects as between which the Commissioner may require restriction. This, in turn, depends on the construction of the expression "independent and distinct" inventions.

"Independent", of course, means not dependent. If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that 35 U.S.C. 121: "enacts as law existing practice with respect to division, at the same time introducing a number of changes."

The report on the hearings does not mention as a change that is introduced, the subjects between which the Commissioner may properly require division.

The term "independent" as already pointed out, means not dependent. A large number of subjects between which, prior to the 1952 Act, division had been proper, are dependent subjects, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section 121 of the 1952 Act were intended to direct the Commissioner never to approve division between dependent inventions, the word "independent" would clearly have been used alone. If the Commissioner has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the term "independent", indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact, "distinct" inventions, even though dependent.

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INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

It is further noted that the terms "independent" and "distinct" are used in decisions with varying meanings. All decisions should be read carefully to determine the meaning intended."

The arguments presented in the MPEP seem to rest on two pillars:

- 1) Apparently, the novel statutory construction theory being put forward is that in the absence of legislative history on a given point, the law doesn't mean what the law says. Applicant submits that the statutory construction as described by the Supreme Court should be given deference: "[I]n interpreting a statute a court should always turn to one cardinal canon before all others. . . . [C]ourts must presume that a legislature says in a statute what it means and means in a statute what it says there." ¹ Certainly, "[w]hen the words of a statute are unambiguous, then, this first canon is also the last: 'judicial inquiry is complete.' " Id.
- 2) "Independent and distinct" has the same meaning as "distinct." This is a logical impossibility if "independent" and "distinct" have different definitions, yet MPEP § 802.01 concedes that that they do have different definitions and helpfully provides them.

Therefore, the applicants suggest that the Patent Office has not satisfied 35 U.S.C 121 in the restriction requirement. If the Patent Office wishes to maintain the restriction requirement, the Applicant respectfully requests that the Patent Office also explain how the subject matter

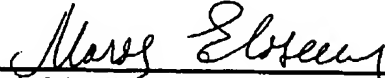
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represents two "independent" inventions, according to the definition of "independent" given in MPEP § 802.01.

A one-month extension of time is requested.

Dated: August 18, 2004.

Respectfully submitted,



Maria M. Eliseeva, Reg. No. 43,328
Houston Eliseeva LLP
4 Militia Drive, Ste. 4
Lexington, MA 02421
Tel: 781-863-9991
Fax: 781-863-9931

¹ Connecticut Nat'l Bank v. Germain, 112 S. Ct. 1146, 1149 (1992).

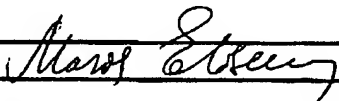
PTO/SB/21 (02-04)

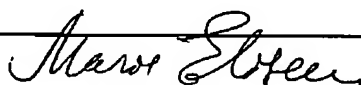
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/065,776	
	Filing Date	November 18, 2002	
	First Named Inventor	Christopher Chen	
	Art Unit	3725	
	Examiner Name	Larson, Lowell A.	
Total Number of Pages in This Submission	4	Attorney Docket Number	23399.0001

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Maria M. Eliseeva
Signature	
Date	August 18, 2004

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Typed or printed name	Maria Eliseeva		
Signature		Date	August 18, 2004

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**FEE TRANSMITTAL
for FY 2004**

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27TOTAL AMOUNT OF PAYMENT (\$)**55.00****Complete If Known**

Application Number	10/065,776
Filing Date	November 18, 2002
First Named Inventor	Christopher Chen
Examiner Name	Larson, Lowell A.
Art Unit	3725
Attorney Docket No.	23399.0001

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☐ Deposit Account:Deposit Account Number
502233Deposit Account Name
Houston Eliseeva LLP

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
SUBTOTAL (1)			(\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent	-20** =	X	
Multiple Dependent	-3** =	X	

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1202 18	2202 9	Claims in excess of 20	
1201 86	2201 43	Independent claims in excess of 3	
1203 290	2203 145	Multiple dependent claim, if not paid	
1204 86	2204 43	** Reissue independent claims over original patent	
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)			(\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for <i>ex parte</i> reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	55.00
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 840	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1808 180	1808 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)**55.00****SUBMITTED BY**

Name (Print/Type)	Maria M. Eliseeva	Registration No. (Attorney/Agent)	43,328	Telephone	781-863-9991
Signature		Date	August 18, 2004		

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